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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Social Work P.R.N.

Serial No. 76/264,699

Wm. Bruce Day of Swanson Midgley for Social Work P.R.N.

Doritt Carroll, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Quinn, Hohein, and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Social Work P.R.N., a corporation of Kansas, has filed
an application to register the mark SOCIAL WORK P.R.N. on
the Principal Register for "temporary employment agency in
the field of social work."¹ The application includes a
disclaimer of "social work" apart from the mark as a whole.

¹ Serial No. 76/264,699, in International Class 35, filed May 31, 2001,
based on use in commerce, alleging first use and use in commerce as of
August 24, 1992.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the marks NURSES PRN² and PRN,³ previously registered for "temporary nursing services," in International Class 42, that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the

² Registration No. 1,591,419 issued April 10, 1990, to PRN Health Services, Inc. The registration includes a disclaimer of "nurses" apart from the mark as a whole. The registration states that the registrant is also the owner of Registration No. 1,242,392, although the owner's name on the cited registration is only slightly different from this owner's name. It is likely that the same party owns both registrations. [Sections 8 and 15 declarations accepted and acknowledged, respectively, and renewed for a ten-year period from April 10, 2000.]

³ Registration No. 1,242,392 issued June 14, 1983, to PRN, Inc. [Sections 8 and 15 declarations accepted and acknowledged, respectively.]

essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney contends that the dominant portion of applicant's mark is PRN, which is one of the registered marks in its entirety, and, she contends, the dominant portion of the other registered mark. The Examining Attorney argues that PRN has the same connotation in applicant's mark and the registered marks, noting that applicant stated that PRN means "as needed"⁴; and that PRN is a strong mark in the field of employment referral services. Finally, the Examining Attorney contends that the services are related because both applicant and registrant(s) "provide temporary placement of health professionals."

Applicant contends that each of these marks is weak and entitled to only a narrow scope of protection; that applicant's mark was registered until applicant failed to file a Section 8 affidavit and these registrations

⁴ We take judicial notice of the following definitions of the term "prn": "abbr. Latin. pro re nata (as the situation demands; as needed)" [*The American Heritage Dictionary of the English Language*, 4th ed. 2000]; and "abbreviation meaning 'when necessary' (from the Latin 'pro re nata,' for an occasion that has arisen, as circumstances require, as needed). One of a number of hallowed abbreviations of Latin terms that have traditionally been used in prescriptions" [*MedicineNet.com*, www.medterms.com, October 3, 2002].

coexisted; that applicant's services are not in the "medical field"; that nursing and social work are entirely different professions; and that the marks create different commercial impressions.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In the first instance, applicant incorporates into its mark the registered mark, "PRN," in its entirety. In the second instance, applicant uses the same format as the registered mark, "NURSES PRN," by placing a noun indicating a profession before the term "PRN." The marks differ to the extent that the cited registration refers to the actual professionals, *i.e.*, "nurses," whereas applicant's mark refers to the field, *i.e.*, "social work." Despite this slight difference, we agree with the Examining Attorney that applicant's mark is significantly similar to both of the cited marks.

As applicant states, and as the judicially noted references indicate, "p.r.n." is an acronym meaning "as needed." Clearly, this term is highly suggestive of temporary employment services, *i.e.*, personnel are provided on an "as needed" basis. Each of the marks involved herein is extremely weak because it involves the term "PRN" alone or in combination with a merely descriptive term, *i.e.*, "NURSES PRN," and "SOCIAL WORK P.R.N." While it is clear that even suggestive and weak marks are entitled to protection, the scope of protection is limited.

Thus, we consider the services involved in this case, and we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the

goods or services recited in the registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). The Examining Attorney has submitted no evidence regarding the respective services involved herein. She merely concludes that both nurses and social workers are health professionals. Not only is this allegation not supported by any evidence in the record, but also there is no evidence that it is common for the same temporary employment agencies to furnish both social workers and nurses to hospitals, nursing homes, individuals needing in-home services, or other facilities needing these temporary personnel. Therefore, we cannot conclude that the recited services are sufficiently related or similar such that, if identified by substantially similar marks, the relevant purchasers would mistakenly believe that they emanate from the same or related source.

Therefore, we conclude that in view of the weak and highly suggestive nature of applicant's mark, "SOCIAL WORK P.R.N.," and the cited marks, "PRN" and "NURSES PRN," and the differences in the respective services in this case,

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confusion as to the source or sponsorship of such services has not been established.

Decision: The refusal under Section 2(d) of the Act is reversed.